

ESTTA Tracking number: **ESTTA654778**

Filing date: **02/09/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Insight Direct USA, Inc.
Granted to Date of previous extension	02/08/2015
Address	6820 South Harl Avenue Tempe, AZ 85283 UNITED STATES
Attorney information	Nina Habib Borders REED SMITH LLP 10 S WACKER DR CHICAGO, IL 60606-7453 UNITED STATES ipdocket-chi@reedsmith.com, nborders@reedsmith.com

Applicant Information

Application No	86217257	Publication date	08/12/2014
Opposition Filing Date	02/09/2015	Opposition Period Ends	02/08/2015
Applicant	Performant Systems Group, LLC 37000 Grand River Avenue, Suite 310 Farmington Hills, MI 48335 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Computer software development, cloud hosting provider services, and computer system integration services for organizing strategic data assets, displaying data via interfaces and graphical dashboards, and disseminating data via cloud and mobile applications

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4508474	Application Date	06/08/2007
Registration Date	04/08/2014	Foreign Priority Date	NONE
Word Mark	INSIGHT		


Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 037. First use: First Use: 1991/09/00 First Use In Commerce: 1991/09/00 Installation of computer hardware, servers, and networks; maintenance and repair of computer hardware, servers, and networks</p> <p>Class 042. First use: First Use: 1991/09/00 First Use In Commerce: 1991/09/00 Consulting services in the fields of selection and implementation of computer hardware and software systems for others for voice over internet protocol (VOIP) and internet telephony; Consulting services, namely, computer software, hardware, server, network and work station selection, implementation and design for others; computer software, hardware, server and network development; Technical support, namely, testing technological functions of computer hardware, servers and networks; computer services, namely, configuration of computer hardware, software, servers and networks; installation of computer software; implementation of computer software; testing and maintenance of computer software; technical support services, namely, troubleshooting of computer hardware and software problems; maintenance of computer software; computer security services, namely, restricting access by computer networks in connection with e-mail, spam, viruses, worms, websites, or other undesired content</p>

U.S. Registration No.	3690982	Application Date	06/08/2007
Registration Date	10/06/2009	Foreign Priority Date	NONE
Word Mark	INSIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1989/09/00 First Use In Commerce: 1989/09/00 Distributorship services and computerized on-line retail store services featuring computer hardware and software, computer components and computer accessories and supplies; asset disposal services, namely, assisting in the disposal of computer hardware, software, servers, networks, and workstations; la-</p>		

	<p>beling, tagging, and tracking services, namely, monitoring and tracking of computer hardware, software, servers, networks, and workstations; domestic and international pricing services, namely, pricing computer hardware and software, computer components and computer accessories and supplies for others; domestic and international procurement services, namely, purchasing computer hardware and software, computer components and computer accessories and supplies for others</p> <p>Class 039. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 Electronic storage of computer data</p> <p>Class 042. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 Computer consultation in the field of computer hardware, software, server, network and workstation analyses for performance, access, configuration, compatibility, and connectivity; Leasing of computers, computer components and computer accessories; Leasing of computers, computer components and computer accessories, and supplies, namely, leasing of computers, servers, bridge/routers, hubs, workstations, laptop computers, monitors, computer cabinets and peripherals; Remote computer back-up services; consolidation of computer data, namely, electronic manipulation of dispersed data to centralized servers to facilitate efficient data back-up and archiving</p> <p>Class 045. First use: First Use: 1997/08/00 First Use In Commerce: 1997/08/00 Licensing of computer software</p>
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U.S. Registration No.	1940956	Application Date	12/08/1994
Registration Date	12/12/1995	Foreign Priority Date	NONE
Word Mark	INSIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 1994/04/14 First Use In Commerce: 1994/04/14 mail order catalog services and retail store services of microcomputers and components, including sound boards, microprocessors, mother boards, memory chips, host adaptors, disk accelerators, controllers, acceleration boards; notebook computers and components, including sound boards, microprocessors, mother boards, memory chips, host adaptors, disk accelerators, controllers, acceleration boards; computer accessories and peripherals; CD-ROM components; software and accessories; printers, accessories and supplies; monitors, both internal and external; scanners; hard drives, both internal and external; floppy drives, both internal and external; tape backup components; data storage and mass storage products; memory systems; power supplies; modems; sound equipment, namely speakers, headphones, microphones and sound cards; multi-</p>		

	mediacomponents, namely joysticks, drives, multimedia cards, software, speakers, microphones, video card and monitors, videotapes; PCMCIA cards and jacks; networking modules and products; T-shirts
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U.S. Registration No.	4396558	Application Date	11/12/2010
Registration Date	09/03/2013	Foreign Priority Date	NONE
Word Mark	INSIGHTCLOUD		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Distributorship services and computerized on-line retail store services featuring computer hardware and software, computer components and computer accessories and supplies; domestic and international price comparison services, namely, pricing computer hardware and software, computer components and computer accessories and supplies for others; domestic and international procurement services, namely, purchasing computer hardware and software, computer components and computer accessories and supplies for others</p> <p>Class 036. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Financial services, namely, financing services related to computer hardware, software, server, networks, and work stations; underwriting warranty programs in the field of computer hardware, software, servers, networks, and work stations; warranty claims administration services, namely, processing warranty claims for computer hardware, software, servers, networks and work stations</p> <p>Class 039. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Electronic storage of computer data</p> <p>Class 042. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Computer programming services; design, development, deployment, implementation, analysis, integration, and management of computer software for others; installation, modification, maintenance, and repair of computer software; customization and computer programming services for others in the field of computer software and hardware configuration management; managed information technology services and operations for others, namely, remote and on-site management of virtual infrastructure and cloud computing systems, networking, applications and storage services of others; application service provider services, namely, hosting computer software applications of others; providing temporary use of nondownloadable computer software for managing, testing, and using multiple operating systems; providing temporary use of nondownloadable computer software for managing virtual computing infrastructure, networking and storage; providing temporary use of nondownloadable computer software for creating and maintaining scalable cloud computing applications; leasing and rental of computer software; technical support services, namely, trouble shooting of computersoftware and computer hardware; consulting services related to vir-</p>		

	<p>tual infrastructure and the field of cloud computing;computer systems integration services; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of Internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; computer consultation in the field of computer hardware, software, server, network and workstation analyses for performance, access, configuration, compatibility, and connectivity; leasing of computers, computer components and computer accessories; leasing of computers, computer components and computer accessories, and supplies, namely, leasing of computers, servers,bridge/routers, hubs, workstations, laptop computers, monitors, computer cabinets and peripherals; remote computer back-up services; consolidation of computer data, namely, electronic manipulation ofdispersed data to centralized servers to facilitate efficient data back-up and archiving</p> <p>Class 045. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31</p> <p>Licensing of computer software</p>
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Attachments	<p>77201950#TMSN.png(bytes)</p> <p>77201689#TMSN.png(bytes)</p> <p>74608621#TMSN.png(bytes)</p> <p>85175925#TMSN.png(bytes)</p> <p>Notice of Opposition.pdf(24520 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Nina Habib Borders/
Name	Nina Habib Borders
Date	02/09/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Insight Direct USA, Inc.

Opposer,

v.

Performant Systems Group, LLC,

Applicant.

Opposition No. _____

Application No.: 86/217,257
Filing Date: March 11, 2014
Publication Date: August 12, 2014
Mark: INCITE INFORMATICS

NOTICE OF OPPOSITION

Insight Direct USA, Inc. ("Insight"), a corporation duly organized and existing under the laws of the State of Illinois, with its principal place of business located at 6820 South Harl Ave., Tempe, Arizona, 85283, will be damaged by the registration of the above-identified mark and hereby opposes the registration, pursuant to 15 U.S.C. § 1063 and 37 C.F.R. § 2.101.

As grounds for opposition, Insight alleges:

1. Opposer Insight is the owner of U.S. Trademark Registration Nos. 4,508,474 for INSIGHT, registered on April 8, 2014. The mark has been in use in commerce at least as early as September 30, 1991. The registration covers the following services in Classes 37 and 42:

IC 37: Installation of computer hardware, servers, and networks; maintenance and repair of computer hardware, servers, and networks.

IC 42: Consulting services in the fields of selection and implementation of computer hardware and software systems for others for voice over internet protocol (VOIP) and internet telephony; Consulting services, namely, computer software, hardware, server, network and work station selection, implementation and design for others; computer software, hardware, server and

network development; Technical support, namely, testing technological functions of computer hardware, servers and networks; computer services, namely, configuration of computer hardware, software, servers and networks; installation of computer software; implementation of computer software; testing and maintenance of computer software; technical support services, namely, troubleshooting of computer hardware and software problems; maintenance of computer software; computer security services, namely, restricting access by computer networks in connection with e-mail, spam, viruses, worms, websites, or other undesired content.

2. Opposer Insight is the owner of U.S. Trademark Registration No. 3,690,982 for INSIGHT, registered on October 6, 2009. The mark has been in use in commerce at least as early as September 30, 1989 for the services listed in Class 35, at least as early as August 31, 2002 for the services listed in Classes 39 and 42, and at least as early as August 31, 1997 for the services listed in Class 45. The registration covers the following services in Classes 35, 39, 42 and 45:


IC 35: Distributorship services and computerized on-line retail store services featuring computer hardware and software, computer components and computer accessories and supplies; asset disposal services, namely, assisting in the disposal of computer hardware, software, servers, networks, and workstations; labeling, tagging, and tracking services, namely, monitoring and tracking of computer hardware, software, servers, networks, and workstations; domestic and international pricing services, namely, pricing computer hardware and software, computer components and computer accessories and supplies for others; domestic and international procurement services, namely, purchasing computer hardware and software, computer components and computer accessories and supplies for others.

IC 39: Electronic storage of computer data.

IC 42: Computer consultation in the field of computer hardware, software, server, network and workstation analyses for performance, access, configuration, compatibility, and connectivity; Leasing of computers, computer components and computer accessories; Leasing of computers, computer components and computer accessories, and supplies, namely, leasing of computers, servers, bridge/routers, hubs, workstations, laptop computers, monitors, computer cabinets and peripherals; Remote computer back-up services; consolidation of computer data, namely, electronic manipulation of dispersed data to centralized servers to facilitate efficient data back-up and archiving.

IC 45: Licensing of computer software.

3. Opposer Insight is the owner of U.S. Trademark Registration No. 1,940,956 for

Insight (& Design) , registered on December 12, 1995. The mark has been in use in commerce at least as early as April 14, 1994. The registration covers the following services in Class 42:

IC 42: mail order catalog services and retail store services of microcomputers and components, including sound boards, microprocessors, mother boards, memory chips, host adaptors, disk accelerators, controllers, acceleration boards; notebook computers and components, including sound boards, microprocessors, mother boards, memory chips, host adaptors, disk accelerators, controllers, acceleration boards; computer accessories and peripherals; CD-ROM components; software and accessories; printers, accessories and supplies; monitors, both internal and external; scanners; hard drives, both internal and external; floppy drives, both internal and external; tape backup components; data storage and mass storage products; memory systems; power supplies; modems; sound equipment, namely speakers, headphones, microphones and sound cards; multimedia components, namely joysticks, drives, multimedia cards, software, speakers, microphones, video card and monitors, video tapes; PCMCIA cards and jacks; networking modules and products; T-shirts.

4. Opposer Insight is the owner of U.S. Trademark Registration No. 4,396,558 for INSIGHTCLOUD, registered on September 3, 2013. The mark has been in use in commerce at least as early as January 31, 2011. The registration covers the following services in Classes 35, 36, 39, 42 and 45:

IC 35: Distributorship services and computerized on-line retail store services featuring computer hardware and software, computer components and computer accessories and supplies; domestic and international price comparison services, namely, pricing computer hardware and software, computer components and computer accessories and supplies for others; domestic and international procurement services, namely, purchasing computer hardware and software, computer components and computer accessories and supplies for others.

IC 36: Financial services, namely, financing services related to computer hardware, software, server, networks, and work stations; underwriting warranty programs in the field of computer hardware, software, servers, networks, and work stations; warranty claims administration services, namely, processing warranty claims for computer hardware, software, servers, networks and work stations.

IC 39: Electronic storage of computer data.

IC 42: Computer programming services; design, development, deployment, implementation, analysis, integration, and management of computer software for others; installation, modification, maintenance, and repair of computer software; customization and computer programming services for others in the field of computer software and hardware configuration management; managed information technology services and operations for others, namely, remote and on-site management of virtual infrastructure and cloud computing systems, networking, applications and storage services of others; application service provider services, namely, hosting computer software applications of others; providing temporary use of nondownloadable computer software for managing, testing, and using multiple operating systems; providing temporary use of nondownloadable computer software for managing virtual computing infrastructure, networking and storage; providing temporary use of nondownloadable computer software for creating and maintaining scalable cloud computing applications; leasing and rental of computer software; technical support services, namely, trouble shooting of computer software and computer hardware; consulting services related to virtual infrastructure and the field of cloud computing; computer systems integration services; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of Internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; computer consultation in the field of computer hardware, software, server, network and workstation analyses for performance, access, configuration, compatibility, and connectivity; leasing of computers, computer components and computer accessories. leasing of computers, computer components and computer accessories, and supplies, namely, leasing of computers, servers, bridge/routers, hubs, workstations, laptop computers, monitors, computer cabinets and peripherals; remote computer back-up services; consolidation of computer data, namely, electronic manipulation of dispersed data to centralized servers to facilitate efficient data back-up and archiving.

IC 45: Licensing of computer software.

5. Opposer Insight owns all rights in and to the ‘474, ‘982, ‘956 and ‘558 registrations and the marks depicted therein. The registered marks of Opposer Insight are valid and subsisting and are prima facie evidence of Opposer Insight’s exclusive rights to use said marks in commerce on the services specified in the registrations.

6. Opposer Insight’s use of the ‘474, ‘982, ‘956 and ‘558 registrations has been valid and continuous since the dates of first use and has not been abandoned. Opposer Insight’s

INSIGHT, INSIGHT (& Design) , and INSIGHTCLOUD marks are symbolic

of extensive good will and consumer recognition built up by Opposer Insight through substantial amounts of time and effort in advertising and promotion, and have come to identify Insight and distinguish its goods and services from those of competitors—which is of significant value to Opposer Insight.

7. Applicant Performant Systems Group, LLC (“Performant”) seeks to register the trademark INCITE INFORMATICS in Class 42 for the following services:

IC 42: Computer software development, cloud hosting provider services, and computer system integration services for organizing strategic data assets, displaying data via interfaces and graphical dashboards, and disseminating data via cloud and mobile applications.

8. Given the similarity of Performant’s mark, and the related nature of the services and channels of trade, registration of the mark depicted in U.S. Trademark Application No. 86/217,257 will create a serious conflict with Opposer Insight’s trademark use and registrations. This conflict is likely to cause confusion, mistake, or deception as to affiliation, connection, or association of Performant with Opposer Insight, or as to the origin, sponsorship, or approval of Performant’s services by Opposer Insight (which they are not).

9. Based on Opposer Insight’s averments herein, registration of U.S. Trademark Application No. 86/217,257 should be denied.

WHEREFORE, Opposer Insight hereby petitions the Board for an Order denying registration of the mark depicted in U.S. Trademark Application No. 86/217,257.

DATED this the 9th day of February, 2015:

s/ Nina Habib Borders

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Counsel for Insight Direct USA, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served via First Class U.S. mail and electronic mail on Applicant's Attorney/Correspondent of Record:

John C. Blattner
DICKINSON WRIGHT PLLC
350 S. Main Street, Suite 300
Ann Arbor, MI 48104-2131

Dated: February 9, 2015

s/ Joshua W. Newman

Attorney for Opposer